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Patent Application Number: 10/163,688

Attorney Docket Number: A2489-US-NP

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Date November 1, 2005


Michael J. Nickerson, Reg. # 33,265

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: R. Enrique VITURRO et al. **GROUP:** 2863

SERIAL NO: 10/673,688 **EXAMINER:** J. Le

FILED: September 29, 2003 **CONFIRMATION:** 1300

**FOR: A METHOD FOR CALIBRATING A MARKING SYSTEM TO
MAINTAIN COLOR OUTPUT CONSISTENCY ACROSS
MULTIPLE PRINTERS**

**Mail Stop: PETITIONS
Commissioner for Patents
PO Box 1450
Alexandria, Virginia 22313-1450**

Sir:

EXPEDITED CONSIDERATION REQUESTED

PETITION UNDER 37 C.F.R. 1.181

The Applicant respectfully petitions the Honorable Commissioner, under 37 C.F.R. 1.181, to invoke the Commissioner's supervisory authority and instruct the Examiner to immediately enter the amendments filed on September 26, 2005, in view of the facts and reasons set forth below.

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Statement of Facts

1. On June 9, 2005, the Examiner issued a Notice of Allowance for the above-identified application.
2. On June 15, 2005, the Applicant submitted the Issue Fee transmittal form with the appropriate fees.
3. On September 20, 2005, after the payment of the Issue Fee and after the final date to pay such an Issue Fee, the Publishing Division issued a Notice of Drawing Inconsistency with Specification asking the Applicant to correct an informality in the specification.
4. On September 26, 2005, the Applicant filed an Amendment correcting the informality in the specification as requested by the Publishing Division.
5. On October 27, 2005, the Examiner issued a Communication denying entry of the amendments filed on September 26, 2005, indicating that the Amendment of September 26, 2005 failed to be accompanied by a Petition under 37 C.F.R. 1.313(c)(1).

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REMARKS

As noted above, the above-identified application was allowed on June 9, 2005. To expedite the issuance of the patentable claims of the above-identified application, the Applicant submitted the Issue Fee transmittal form with the appropriate fees on June 15, 2005.

After the payment of the Issue Fee and after the final date to pay such an Issue Fee (September 9, 2005), the Publishing Division issued a Notice of Drawing Inconsistency with Specification asking the Applicant to correct an informality in the specification.

Thereafter, as noted above, the Applicant filed an Amendment correcting the informality in the specification as requested by the Publishing Division on September 26, 2005. In response to the Applicant's Amendment, the Examiner issued a Communication denying entry of the amendments filed on September 26, 2005, indicating that the Amendment of September 26, 2005 failed to be accompanied by a Petition under 37 C.F.R. 1.313(c)(1).

37 C.F.R. 1.313(c) states:

Once the issue fee has been paid, the application will not be withdrawn from issue upon petition by the applicant for any reason except:

(1) Unpatentability of one of more claims, which petition must be accompanied by an unequivocal statement that one or more claims are unpatentable, an amendment to such claim or claims, and an explanation as to how the amendment causes such claim or claims to be patentable;

(2) Consideration of a request for continued examination in compliance with § 1.114; or

(3) Express abandonment of the application. Such express abandonment may be in favor of a continuing application.

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The Examiner asserts that the Amendment of September 26 should have been accompanied by a Petition under 37 C.F.R. 1.313(c)(1). 37 C.F.R. 1.313(c)(1) states that once the issue fee has been paid, the application will not be withdrawn from issue upon petition by the applicant for any reason except for the unpatentability of one of more claims. 37 C.F.R. 1.313(c)(1) further states that the petition must be accompanied by an unequivocal statement that one or more claims are unpatentable. Lastly, 37 C.F.R. 1.313(c)(1) states that the petition should be accompanied by an amendment amending such claim or claims and an explanation as to how the amendment causes such claim or claims to be patentable.

The Applicant could not file a Petition under 37 C.F.R. 1.313(c)(1) with the Amendment of September 26, 2005 because the allowed claims are patentable. Moreover, the US Patent Office deemed the claims to be patentable. If the US Patent Office did not deem the claims to be patentable, the US Patent Office should have withdrawn the above-identified application from issuance under 37 C.F.R. 1.313(b)(3). Since it is clear from the record that the US Patent Office did not withdraw the above-identified application from issuance under 37 C.F.R. 1.313(b)(3), it can be concluded that the US Patent Office deemed the claims to be patentable.

Therefore, the Applicant **could not make** the required **"unequivocal"** statement that one or more claims are unpatentable, as **expressly** required by 37 C.F.R. 1.313(c)(1) because the both the Applicant and the US Patent Office have made independent determinations that the allowed claims are patentable.

Moreover, the Notice of Drawing Inconsistency with Specification merely asked the Applicant to correct an informality in the specification, not the claims. Therefore, the Applicant **could not file** the required **amendments to the claims**, as **expressly** required by 37 C.F.R. 1.313(c)(1), nor could the Applicant explain how such a *non-existent* amendment now caused the claims to be patentable, as **expressly** required by 37 C.F.R. 1.313(c)(1).

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In summary, the expressed requirements of 37 C.F.R. 1.313(c)(1) require the Applicant an unequivocal statement that one or more claims are unpatentable. Moreover, both the Applicant and the US Patent Office have made independent determinations that the allowed claims are patentable. Thus, the Applicant could not file a Petition under 37 C.F.R. 1.313(c)(1), without the Applicant's Representative breaching the ethical obligations under 37 C.F.R. 10.18(b)(1) or committing perjury, because the expressed requirements of 37 C.F.R. 1.313(c)(1) require the Applicant an unequivocal statement that one or more claims are unpatentable.

In the alternative, if the Examiner considers the informality noted by the Publishing Division to have rendered the claims unpatentable, it is respectfully submitted that the above-identified application was withdrawn from issuance under 37 C.F.R. 1.313(b)(3), *de facto*, with the mailing of the Notice of Drawing Inconsistency with Specification on September 20, 2005. Therefore, since the above-identified application had already been withdrawn from issuance, *de facto*, by the Publishing Division with the mailing of the Notice of Drawing Inconsistency with Specification on September 20, 2005, a petition by the Applicant requesting the same would be moot and unnecessary.

Notwithstanding the above arguments, if the Honorable Commissioner determines that some type of petition under 37 C.F.R. 1.313(c) should have been filed with the Amendment of September 26, 2005, the Honorable Commissioner is respectfully requested to give the Applicant thirty days to remedy the situation because the requirement of a Petition under 37 C.F.R. 1.313(c) is, at best, unclear.

It is the Applicant's position that the requirement of a Petition under 37 C.F.R. 1.313(c)(1) is without merit. Moreover, it is the Applicant's position that the filing of a Petition under 37 C.F.R. 1.313(c)(1) would require the Applicant's Representative to breach the ethical obligations under 37 C.F.R. 10.18(b)(1) and commit perjury. Lastly, it is the Applicant's position that the above-identified application was withdrawn from issuance under 37 C.F.R. 1.313(b)(3), *de facto*, with the mailing of the Notice of Drawing Inconsistency with Specification on September 20, 2005.

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SUMMARY

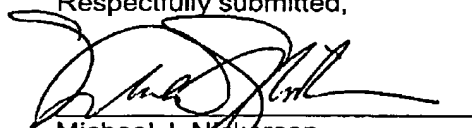
The requirement of a Petition under 37 C.F.R. 1.313(c)(1) is without merit. Moreover, the filing of a Petition under 37 C.F.R. 1.313(c)(1) would require the Applicant's Representative to breach the ethical obligations under 37 C.F.R. 10.18(b)(1) and commit perjury. Lastly, the above-identified application was withdrawn from issuance under 37 C.F.R. 1.313(b)(3), *de facto*, with the mailing of the Notice of Drawing Inconsistency with Specification on September 20, 2005.

CONCLUSION

Therefore, in view of the above stated facts and arguments, the Applicant respectfully requests the Honorable Commissioner, under 37 C.F.R. 1.181, to invoke the Commissioner's supervisory authority and instruct the Examiner to immediately enter the amendments filed on September 26, 2005. In the alternative, in view of the above stated facts and arguments, the Applicant respectfully requests the Honorable Commissioner, under 37 C.F.R. 1.181, to invoke the Commissioner's supervisory authority and instruct the Examiner to give the Applicant thirty days to cure the alleged defect in the Amendment filed on September 26, 2005.

The Honorable Commissioner is respectfully encouraged to contact the undersigned to discuss the circumstances warranting this Petition.

Respectfully submitted,



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